

Application Serial No. 10/525,902
Reply to Office Action of June 11, 2008

PATENT
Docket: CU-4101

REMARKS

In the Office Action, dated June 11, 2008, the Examiner states that Claims 1, 5, 7-10 and 16 are pending and rejected. By the present Amendment, Applicant amends the claims.

1. Rejection of Claims 1, 5, 7, 9-10 and 16 under 35 U.S.C. 103(a)

Claims 1, 5, 7, 9-10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robson (U.S. Pub. 2003/0148895) in view of Emert (U.S. 5,498,809) and Shanklin (U.S. 6,008,165) for the reasons of record. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Emert, Shanklin and Curtis (U.S. Pub. 2003/0220209). Applicant respectfully disagrees with and traverses these rejections.

Applicant respectfully asserts that Robson discloses a "borated dispersant" in Table 1. In contrast thereto, the amended claims recite a "non-borated bis succinimide" and "polybutenylsuccinimide (bis type)." Robson is absolutely silent with respect to these compounds and teaches away from "non-borated bis succinimide" by teaching a "borated dispersant."

Emert discloses beta-(3,5-di-tert-butyl-4-hydroxyphenyl)propionic acid esters in column 71, lines 47-48, but octyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate, which is found in Claim 17, is not taught or suggested.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007). In view of the aforementioned deficiencies in the prior art, Applicant respectfully asserts that even if the prior art was combined as suggested by the Office Action, the resultant would still fall short of yielding the claimed invention. As such, Applicant respectfully requests withdrawal of the rejected claims under 35 U.S.C. 103(a).

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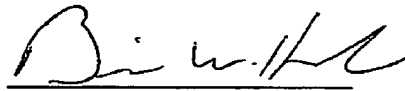
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In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

October 10, 2008

Date



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